## REMARKS

Claims 1, 2, 7, 11-17, 19-21, 23, 24 and 27-80 were presented for examination. The Examiner rejected claims 1, 33, and 53 under 35 U.S.C. 112 second paragraph. The Examiner rejected claims 24 and 73-80 under 35 U.S.C. 103(a) as unpatentable over "Karaoke Revolution" by Ed Lewis (http://ps2.ign.com/articles/458/458064p1.html, hereafter "Lewis") in view of "Britney's Dance Beat" by Perry (http://ps2.ign.com/articles/359/359021p1.html, hereafter "Perry"). The Examiner rejected claims 7, 35, 55, and 72 under 35 U.S.C. 103(a) as unpatentable over Lewis further in view of U.S. Patent 6,514,083 to Kumar et al. ("Kumar"). The Examiner rejected claims 1, 11-17, 19-21, 23, 27-32, 53, and 56-70 under 35 U.S.C. 103(a) as unpatentable over Lewis in further view of "Karaoke Revolution" as sold via http://www.samgoody.com ("Sam Goody"). The Examiner rejected claims 33 and 36-52 under 35 U.S.C. 103(a) as unpatentable over Lewis in further view of "Karaoke Revolution" as sold via http://www.walmart.com. The Examiner rejected claims 2 and 34, 54 under 35 U.S.C. 103(a) as unpatentable over "Dance Dance Revolution" by Smith (http://psx.ign.com/articles/161/161525p1.html, hereafter "Smith"). Applicants note that, although claim 71 was indicated as rejected on the Office Action Summary, no grounds for rejection were given in the Office Action for that claim.

Claims 1, 7, 11, 13, 14, 17, and 19-21 are hereby amended. Claims 18, 24, and 27-80 are hereby cancelled. Claims 81-104 are hereby added. Claims 1 and 87 are independent. No new matter is added. Upon entry of the present amendment claims 1, 2, 7, 11-17, 19-21, 23, and 81-104 will be presented for examination.

### Rejection of claims under 35 U.S.C. 112 second paragraph

The Examiner rejected claims 1, 33, and 53 under 35 U.S.C. 112 second paragraph objecting to the phrases "in a manner typically associated with recorded music products," "music department of a general store," "online music store," and "specialty music store." Applicant has cancelled claims 33 and 53, mooting this rejection with respect to those claims. The present amendment removes those phrases from claim 1 and Applicant submits that the rejection should be withdrawn.

**Rejection of claims under 35 U.S.C. 103(a)**

The Examiner rejected claims 1, 2, 7, 11-17, 19-21, 23, 24, 27-70, 72-80 under 35 U.S.C. 103(a) as unpatentable over various combinations of Lewis, Perry, Kumar, Smith, www.samgoody.com, and www.walmart.com. Claims 18, 24, and 27-80 are hereby cancelled, mooting this rejection with respect to those claims. Applicants traverses this rejection with respect to claim 1 to the extent it is maintained over that claim, as amended. Claim 1, as amended, recites a method for selling a music-based video game in conjunction with a recorded music product, the method including:

> (a) creating a portion of a video game based on a quantum of music content;
> (b) embodying the portion of the video game as a computer-readable medium; and
> (c) offering for sale, as a single unit, an article of manufacture which embodies the quantum of music content in a music playback format and the computer-readable medium embodying the portion of the created video game.

Newly added independent claim 87 recites a method for selling a music-based video game in a manner typically associated with recorded music products, the method comprising the steps of:

> (a) creating a portion of a video game based on a quantum of music content;
> (b) storing, on a server, the portion of the video game;
> (c) offering, via an online store, as a single unit the quantum of music content in a music playback format and the portion of the created video game; and
> (d) transmitting electronically, to a user, the quantum of music content in a music playback format and the portion of the created video game.

Applicant respectfully submits that none of the cited references, taken alone or together, teach or suggest offering, *as a single unit*, music content in a music playback format and a portion of a video game based on the music content as required by independent claims 1 and 87. As described in the application, this may include selling a single disc, such as a CD or DVD comprising both the video game and the music content. This may also comprise selling a CD

with the music content and a separate medium with the video game together as a unit (Application, para. 0056).

**Neither Lewis, Perry or Smith teach or suggest offering for sale, as a single unit, a music-based video game and music in a music playback format**

Lewis, Perry, and Smith describe the video games Karaoke Revolution, Britney's Dance Beat, and Dance Dance Revolution, respectively. In their descriptions of the games, all of the music provided is heard or played within the context of the game. Since Lewis, Perry, and Smith do not teach or suggest offering music in a music playback format, they certainly cannot teach or suggest "offering for sale, as a single unit, an article of manufacture which embodies the quantum of music content in a music playback format and the computer-readable medium embodying the portion of the created video game" as required by independently claims 1 and 87.

**Kumar does not teach or suggest offering, as a single unit, music content in a music playback format and a game based on the music content**

Kumar is cited by the Examiner for the proposition that user input may be received via a camera. Kumar describes a karaoke system where all the recorded music is provided in the context of the karaoke system. Kumar does not describe offering any music in a music playback format other than the music used for the karaoke system. Thus Kumar cannot teach or suggest "offering for sale, as a single unit, an article of manufacture which embodies the quantum of music content in a music playback format and the computer-readable medium embodying the portion of the created video game" as required by claim 1 as currently amended.

**Neither www.samgoody.com nor www.walmart.com teach or suggest offering for sale, as a single unit, a music-based video game and music in a music playback format**

www.samgoody.com and www.walmart.com sell the video game Karaoke Revolution in addition to selling individual articles of recorded music, but these articles are sold separately by those sources. Thus neither www.samgoody.com nor www.walmart.com teach or suggest "offering for sale, *as a single unit*, an article of manufacture which embodies the quantum of

music content in a music playback format and the computer-readable medium embodying the portion of the created video game" as required by claim 1 as currently amended.

**No combination of references teaches or suggests the limitations of claims 1 or 87**

The Examiner argues in the rejection of claim 1 that music-based video games may share some elements of packaging and marketing with music, and thus "it would be obvious to combine the cite [sic] arts in order to increase the products [sic] exposure to the non-hardcore gaming community, the general public." (Office Action, pages 4-5). Applicant disagrees with this statement in two respects.

First, the Examiner's proposed motivation for combining the cited arts is without support in either the references themselves or the knowledge of one of ordinary skill in the art. The cited references are silent as to both the potential desirability of increasing market share for a music-based video game and to potential means for achieving it. While it may be generally assumed that increasing market share is a good thing, the Examiner fails to cite a reference which teaches or suggests that selling a single unit comprising both a music-based video game with a recorded music product would increase the market for the game. Indeed, the opposite conclusion may just as easily be reached by one of ordinary skill—that selling them as a single unit would reduce the potential market to only those consumers who want both a music-based video game and a recorded music product.

Second, even if the Examiner's statement that combining music content with a video game based on the music content would increase the game's exposure is taken at face value, the vast number of possible combinations of the cited arts do not necessarily or predictably produce invention claimed invention claimed in independent claims 1 and 87. The Examiner provides only a single possible motivation for *any* combination of the cited arts, the Examiner's rejection is silent as to *how* the cited arts could be combined to result in the present invention. Potential combinations of a music-based video game with the music as sold by www.samgoody.com or www.walmart.com are limitless and include, for example, offering music-based video games in a "music" section of the www.samgoody.com web site, offering music-based games on the same web pages as recorded music, displaying recommendations to purchasers of recorded music to purchase a music-based game, offering discounts or promotions linking the purchase of recorded

music along with a music-based video game, and including a music-based video game and recorded music in a single article. Thus this is not a case where "there are a finite number of identified, predictable solutions" See KSR v. Teleflex, 550 U.S. ____ (2007) (finding claim obvious where only a very limited number of linkages between the claimed sensor and pedal were possible). The Examiner's general statement regarding a potentially increased market fails to provide a reason why the particular embodiment required by claims 1 and 87 of offering *as a single unit* the music-based video game and recorded music would be obvious.

For the reasons above, Applicant submits that independent claims 1 and 87 are allowable in their present form and that claims 2, 7, 11-17, 19-21, 23, and 81-86, which depend from claim 1, and claims 88-104, which depend from claim 87 are allowable.

## CONCLUSION

In view of the above remarks and amendments, Applicant believes the pending application is in condition for allowance.

Please charge any additional necessary fees or credit any overpayments to Deposit Account No. 03-1721.

Respectfully submitted,
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